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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,361	07/26/2006	Peter Erk	293579US0PCT	8364
22850 7590 11/15/2007 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER GREEN, ANTHONY J	
			ART UNIT 1793	PAPER NUMBER
			NOTIFICATION DATE 11/15/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/587,361	Applicant(s) ERK ET AL.	
	Examiner Anthony J. Green	Art Unit 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/20/06</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Response to Amendment

1. The preliminary amendment has been entered. After entry of the amendment claims 1-19 are currently pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 it is unclear as to whether or not the phrase "and has a blackness value ≥ 210 in an alkyd/melamine baking varnish" refers to just the mixture of isomers or if it also refers to formula Ia and Ib.

In claim 3 the phrase "the crude pigments obtained in the synthesis" lacks proper antecedent basis. The use of the term "desired" renders the claim vague and indefinite.

The term "high" in claim 4 is a relative term which renders the claim indefinite. The term "high" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

In claim 5 the use of the term "desired" renders the claim vague and indefinite. The term "hot" in claim 6 is a relative term which renders the claim indefinite. The term

"hot" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

The term "hot" in claim 6 is a relative term which renders the claim indefinite. The term "hot" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

In claim 8 the phrase "the crude pigments obtained in the synthesis" lacks proper antecedent basis. The use of the term "desired" renders the claim vague and indefinite.

In claim 9 the use of the term "desired" renders the claim vague and indefinite.

Claim 14 is vague and indefinite as the claim does not set forth any steps involved in the method/process, and therefore it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced. The term "high" is a relative term which renders the claim indefinite. The term "high" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

In claim 15 the use of the term "including" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim 16 is vague and indefinite as the claim does not set forth any steps involved in the method/process, and therefore it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 17 is vague and indefinite as the claim does not set forth any steps involved in the method/process, and therefore it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced. The phrase "leather-like" renders the claim(s) indefinite because the claim includes elements not actually disclosed (those encompassed by "like"), thereby rendering the scope of the claim unascertainable. See MPEP § 2173.05(d).

Claim 18 is vague and indefinite as the claim does not set forth any steps involved in the method/process, and therefore it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 19 is vague and indefinite as the claim does not set forth any steps involved in the method/process, and therefore it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-12 and 18-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Nguyen et al (US Patent No. 5,141,837 A).

The reference teaches, in the claims, and the examples, a perylene pigment produced by milling. See also column 6, lines 42+, and column 19, lines 1+ which teaches the process of making the perylene pigment. Claim 9 recites the formula of the perylene pigment.

The instant claims are met by the reference as the reference teaches a pigment having a formula that encompasses that which is instantly claimed and its use for preparing coating compositions. As for the blackness value, this property appears to be an inherent property as the pigment has the same structure as instantly claimed.

6. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Hayata et al (US Patent No. 6,268,097A).

The reference teaches various pigments having formulas that encompass the instantly claimed formulas (see compounds 12-15 found in column 7).

The instant claims are met by the reference as the reference teaches a pigment having a formula that encompasses that which is instantly claimed. As for the blackness value, this property appears to be an inherent property as the pigment has the same structure as instantly claimed.

7. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent Specification No. 2002-38047A.

The reference teaches on page 2, various pigments having formulas that encompass the instantly claimed formulas.

The instant claims are met by the reference as the reference teaches a pigment having a formula that encompasses that which is instantly claimed. As for the blackness value, this property appears to be an inherent property as the pigment has the same structure as instantly claimed.

8. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent Specification No. 8-6277A.

The reference teaches on pages 2-5, various pigments having formulas that encompass the instantly claimed formulas.

The instant claims are met by the reference as the reference teaches a pigment having a formula that encompasses that which is instantly claimed. As for the blackness value, this property appears to be an inherent property as the pigment has the same structure as instantly claimed.

9. Claims 1-3 and 14-16 are rejected under 35 U.S.C. 102(b) as being anticipated by PCT International Application No. WO 03/010241A.

US 7,105,046 is based on said PCT and is used as the English language translation of the PCT document.

The reference teaches, in the claims, a black perylene pigment having a structure that encompasses that which is instantly claimed. According to the reference the industrial applicability of the pigment is that it is useful as pigments for inks, paints, ink-jet printing inks, electrophotographic toners, rubbers and plastics as well as black matrix materials.

The instant claims are met by the reference as the reference teaches pigments having formulas that encompass that which is instantly claimed. As for the blackness value, this property appears to be an inherent property as the pigment has the same structure as instantly claimed.

10. Claims 1-3, 14-16 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by PCT International Application No. WO 03/010242A.

US 7,083,675 is based on said PCT and is used as the English language translation of the PCT document.

The reference teaches, in the claims, a black perylene pigment having a structure that encompasses that which is instantly claimed. According to the reference the industrial applicability of the pigment is that it is useful as pigments for inks, paints,

ink-jet printing inks, electrophotographic toners, rubbers and plastics as well as black matrix materials. Examples of coating compositions include polyvinyl chloride and polyethylene based coating films.

The instant claims are met by the reference as the reference teaches pigments having formulas that encompass that which is instantly claimed. As for the blackness value, this property appears to be an inherent property as the pigment has the same structure as instantly claimed.

11. Claims 1-2, 14-15 and 18-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Neumann et al (US Patent No. 4,556,622 A).

The reference teaches, in the examples (especially example 2) and the claims, an electrophotographic material comprising a perylene compound that encompasses that which is instantly claimed. The compositions comprise polymer materials as binders.

The instant claims are met by the reference as the reference teaches perylene compounds having formulas that encompass that which is instantly claimed. As for the blackness value, this property appears to be an inherent property as the perylene compounds have the same structure as instantly claimed.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 4-8, 10, 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over PCT International Application No. WO 03/010241A.

US 7,105,046 is based on said PCT and is used as the English language translation of the PCT document.

The reference was discussed above. The reference further teaches, in column 3, lines 35+ of the US equivalent, that the pigment may be subjected to ordinary finishing treatments.

The instant claims are obvious over the reference. While the reference does not recite that the pigment is used for coloring leather and leather-like materials, this appears to be a matter of obvious choice or design as the reference teaches that the pigment is used for coloring various polymers and plastics articles and this is believed to encompass leather-like materials as they are plastic materials. As for claim while the reference does not recite that the pigment is used as charge generating material and as a constituent of the black matrix in LC displays this is believed to be obvious as the reference teaches that the pigments may be used for electrophotographic toners and black matrix materials. As for claim 19 this is believed to be obvious as the reference teaches that the pigments may be used for pigmenting plastics and paints.

14. Claims 4-8, 10, and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over PCT International Application No. WO 03/010241A.

US 7,105,046 is based on said PCT and is used as the English language translation of the PCT document.

The reference was discussed above. The reference further teaches, in column 3, lines 35+ of the US equivalent, that the pigment may be subjected to ordinary finishing treatments.

The instant claims are obvious over the reference. While the reference does not recite that the pigment is used for coloring leather and leather-like materials, this appears to be a matter of obvious choice or design as the reference teaches that the pigment is used for coloring various polymers and plastics articles and this is believed to encompass leather-like materials as they are plastic materials. As for claim while the reference does not recite that the pigment is used as charge generating material and as a constituent of the black matrix in LC displays this is believed to be obvious as the reference teaches that the pigments may be used for electrophotographic toners and black matrix materials.

Allowable Subject Matter

15. Claim 13 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

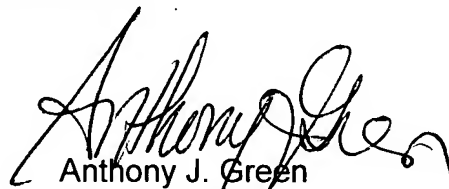
Information Disclosure Statement

16. The remaining references have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the above rejections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony J. Green whose telephone number is 571-272-1367. The examiner can normally be reached on Monday-Thursday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Anthony J. Green
Primary Examiner
Art Unit 1793

ajg
November 5, 2007